

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Storer <i>et al.</i>	Confirmation No.: 2099
Serial No.: 10/735,408	Art Unit: 1623
Filed: December 12, 2003	Examiner: Krishnan, Ganapathy
For: PROCESS FOR THE PRODUCTION OF 2'- BRANCHED NUCLEOSIDES	Attorney Docket No: 11874-027-999 CAM: 417451-999027

**APPLICATION FOR RECONSIDERATION OF DETERMINATION OF PATENT
TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Patentees respectfully request reconsideration of the Determination of Patent Term Adjustment under 35 U.S.C. §154(b) (“Determination”) stated on the Issue Notification of May 6, 2009 in connection with the above-captioned application. It is alleged in the Determination that the patent term adjustment is 89 days. Applicants respectfully disagree. As set forth below, the correct patent term adjustment is 410 days.

A. Statement of the Facts: Calculation of Patent Term Adjustment

1. Patent Office Delays Under 35 U.S.C. §154(b)(1)(A)

Applicants agree with the Office’s Determination with respect to Office delays of 396 days under 35 U.S.C. § 154(b)(1)(A)(i), as provided in the Patent Term Adjustment History obtained from the Patent Application Information Retrieval (“PAIR”) of the United States Patent and Trademark Office website, and provided that a patent issues from the instant application on the Tuesday before the date that is four months after the date of this paper. *See* 37 C.F.R. §1.703(a)(6) (patent term adjustment is equal to the number of days “in the period beginning on the day after the date that is fourteen months after the date the issue fee was paid...and ending on the date a patent was issued”).

The filing date of the instant application is December 12, 2003. Thus, a first action was due February 12, 2005, *i.e.*, fourteen months after the date of filing. *See* 37 C.F.R.

§1.703(a)(1) (patent term adjustment is equal to the number of days “in the period beginning on the day after the date that is fourteen months after the date on which the application was filed...and ending on the date of mailing of...an action under 35 U.S.C. §132....”); 35 U.S.C. 154(b)(1)(A)(i). A Restriction Requirement was not mailed until March 15, 2006. Thus, the period of Office delay for failure to issue an action within 14 months is 396 days.

2. Patent Office Delays Under 35 U.S.C. §154(b)(1)(B)

“[I]f the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application...not including (i) any time consumed by continued examination of the application requested by the application under section 132(b)...the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued.” 35 U.S.C. §154(b)(1)(B). The instant application was filed on December 12, 2003. Thus, the three-year anniversary of the filing date is December 12, 2006. Patentees filed a Request for Continued Examination on October 29, 2007. Thus, the period of Office delay pursuant to 35 U.S.C. §154(b)(1)(B) is 321 days.

3. Total Patent Office Delays

The patent term adjustment due to PTO delays is the sum of Office delays under 35 U.S.C. §154(b)(1)(A) and 35 U.S.C. §154(b)(1)(B). *See Wyeth v. Dudas*, 88 U.S.P.Q.2d 1538 (D.D.C 2008). However, “[t]o the extent that period of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.” *Id.* at 1539, citing 35 U.S.C. §154(b)(2)(A). Overlap occurs “only if they occur on the same calendar day or days.” *Id.* at 1541.

As discussed above, the period of Office delay under 35 U.S.C. §154(b)(1)(A) was between February 12, 2005 and March 15, 2006, *i.e.*, 396 days. The period of Office delay under 35 U.S.C. §154(b)(1)(B) was between December 12, 2006 and October 29, 2007, *i.e.*, 321 days. Because neither of the periods of delay occurred on the same calendar day, the total patent term adjustment due to Office delays is $396 + 321 = 717$ days.

4. Applicants’ Delay under 37 C.F.R. §1.704

Applicants do not dispute the Office’s determination of Applicants’ delay of 307 days, as provided in the Patent Term Adjustment History obtained from PAIR.

A response to Office Action was filed on September 21, 2006 in reply to a Restriction Requirement mailed March 15, 2006. Thus, a delay of 98 days was assessed by the Office in the Determination for the filing of a reply after three months from the mailing date of an Office Action. *See* 37 C.F.R. § 1.704(b).

A response to Office Action was filed on May 23, 2007 in reply to a non-final Office Action mailed December 22, 2006, a delay of 62 days. *Id.*

A response to Office Action was filed on July 7, 2008 in reply to a non-final Office Action mailed January 7, 2008, a delay of 89 days. *Id.*

Finally, a response to Office Action was filed with a Request for Continued Examination on February 20, 2009 in reply to a final Office Action mailed September 24, 2008, a delay of 58 days. *Id.*

Accordingly, the total of Applicants' delay is $98 + 62 + 89 + 58 = \underline{307 \text{ days}}$.

5. Total Patent Term Adjustment

In view of the above, the total patent term adjustment is the difference between total Office delays under 35 U.S.C. §154(b)(1)(A) and (B), and total Applicant delays, *i.e.* 717-307 = 410 days.

B. **Terminal Disclaimers**

No Terminal Disclaimer has been filed in the above-captioned application. Therefore, the correct patent term adjustment is 410 days.

C. **Conclusion**

The fee of \$200.00, which is believed due for the submission of this paper under 37 C.F.R. §1.18(e), will be paid via EFS Web. If any additional fees are due, the Commissioner is authorized to charge them to Deposit Account No. 50-3013 (referencing 417451-999027).

Respectfully submitted,

Date: July 14, 2009

For:


Mark D. Kafka
Dale L. Rieger

Reg. No. 59,569
Reg. No. 43,045

JONES DAY
222 East 41st Street
New York, New York 10017
(858) 314-1200